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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/050,680	01/15/2002	Thomas Joseph Pecorini	05015.0388U2	4839

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EXAMINER

SHOSHO, CALLIE E

ART UNIT	PAPER NUMBER
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1714

DATE MAILED: 08/29/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/050,680	Applicant(s) PECORINI ET AL.	
	Examiner Callie E. Shosho	Art Unit 1714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|-------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>5/8/02</u> . | 6) <input type="checkbox"/> Other: |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 2, 7, 11, 12, and 19-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

(a) Claims 2, 12, and 19 each recite that “the copolymer comprises one or more of : EMA, EMMA, EEA, EBA, or EBA”. In order to avoid any confusion in the scope of the claims, it is suggested that the abbreviations recited in each claim be replaced. For instance, change “EMA” to “ethylene methyl acrylate copolymer”.

(b) Claims 7 and 11 each recite the phrase “I.V.”. In order to avoid any confusion in the scope of the claims, it is suggested that the abbreviation recited in each claim be replaced with “inherent viscosity”.

(c) Claim 19 discloses a method of coloring a polyester composition consisting essentially of adding to base polyester a copolymer. However, given that no colorant is included in the method it is not clear how the base polyester becomes colored. Clarification is requested.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-7, 9-16, and 18-20 are rejected under 35 U.S.C. 102(e) as being anticipated by Petiniot et al. (U.S. 2001,0049424).

Petiniot et al. disclose concentrate comprising pigment and up to 25% copolymer such as ethylene butyl acrylate, ethylene ethyl acrylate, and ethylene methyl acrylate wherein the concentrate contains no water and is used to color polyester. There is further disclosed a polyester composition comprising 0.5-30% of the concentrate and polyester as well as a method of adding the concentrate to the polyester. Petiniot et al. also disclose molded article comprising colored polyester (paragraphs 9, 13, 22-23, 36, and 43). Although there is no disclosure that the inherent viscosity of the polyester composition is equal to or less than about 0.04 g/dL below inherent viscosity of base polyester, given that Petiniot et al. disclose polyester composition identical to that presently claimed, it is clear that such composition would therefore inherently possess inherent viscosity identical to that presently claimed.

In light of the above, it is clear that Petiniot et al. anticipate the present claims.

5. Claims 1-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Scheibelhoffer et al. (U.S. 5,670,561).

Scheibelhoffer et al. disclose color concentrate comprising 1-25% ethylene/(meth)acrylate which contains 40-95% ethylene and colorant wherein the color concentrate comprises less than 0.05% water and is used to color polyester. There is further disclosed a polyester composition comprising 0.1-15% of the concentrate and polyester as well as a method of adding the concentrate to the polyester. Scheibelhoffer et al. also disclose molded article comprising colored polyester (col.1, lines 9-12, col.1, line 66-col.2, line 8, col.6, lines 11-42, col.7, lines 36-62, col.9, lines 38-44, col.10, lines 54-65, and col.11, lines 2 and 29-37).

Although there is no disclosure that the inherent viscosity of the polyester composition is equal to or less than about 0.04 g/dL below inherent viscosity of base polyester, given that Scheibelhoffer et al. disclose polyester composition identical to that presently claimed, it is clear that such composition would therefore inherently possess inherent viscosity identical to that presently claimed.

In light of the above, it is clear that Scheibelhoffer et al. anticipate the present claims.

6. Claims 1-7, 9-16, and 18-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Phillips et al. (U.S. 5,686,515).

Phillips et al. disclose concentrate comprising pigment and 10-30% copolymer such as ethylene methyl acrylate, wherein the concentrate contains no water and is used to color polyester. There is further disclosed a polyester composition comprising 3% of the concentrate and polyester as well as a method of adding the concentrate to the polyester. Phillips et al. also

disclose molded article comprising colored polyester (col.1, lines 8-10, col.3, lines 46-48, col.4, lines 11-15, col.5, lines 16-19, 26, and 49-61, and col.6, lines 61-66). Although there is no disclosure that the inherent viscosity of the polyester composition is equal to or less than about 0.04 g/dL below inherent viscosity of base polyester, given that Phillips et al. disclose polyester composition identical to that presently claimed, it is clear that such composition would therefore inherently possess inherent viscosity identical to that presently claimed.

In light of the above, it is clear that Phillips et al. anticipate the present claims.

7. Claims 1, 3-11, and 13-18 are rejected under 35 U.S.C. 102(b) as being anticipated by Siegle et al. (U.S. 3,766,126).

Siegle et al. disclose color concentrate comprising 80-20% ethylene/ (meth)acrylate which contains 50-95% ethylene and 20-80% colorant wherein the color concentrate is used to color polyester. There is further disclosed a polyester composition comprising 0.5-10% of the concentrate and polyester as well as a method of adding the concentrate to the polyester. It is disclosed that the concentrate is dried for 16 hours before addition to polyester. Siegle et al. also disclose molded article comprising colored polyester (col.1, lines 15-42, col.2, lines 54-59, col.2, line 66-col.3, line 5, col.3, lines 28-53, col.6, lines 21-29, col.7, lines 8-11 and 14-15, col.8, lines 69-72, and col.9, lines 34-36). Although there is no disclosure that the inherent viscosity of the polyester composition is equal to or less than about 0.04 g/dL below inherent viscosity of base polyester, given that Siegle et al. disclose polyester composition identical to that presently claimed, it is clear that such composition would also therefore inherently possess inherent viscosity identical to that presently claimed.

In light of the above, it is clear that Siegle et al. anticipate the present claims.

8. Claims 1-3 are rejected under 35 U.S.C. 102(b) as being anticipated by Rondy et al. (U.S. 5,824,731).

Rondy et al. disclose color concentrate which comprises 20-70% carbon black and thus, 80-30% polymer including ethylene (meth)acrylate copolymer (col.3, line 64-col.4, line 19 and col.6, lines 10-19).

In light of the above, it is clear that Rondy et al. anticipate the present claims.

9. **NOTE:** With respect to the rejections of claims 19-20 by Scheibelhoffer et al. (U.S. 5,670,561) and Phillips et al. (U.S. 5,686,515) in paragraphs 5 and 6 above, it is noted that claim 19 recites method "consisting essentially of" adding copolymer to base polyester. While Scheibelhoffer et al. and Phillips et al. disclose the addition of resin and wax, respectively, to base polyester in addition to the copolymer, it is noted that while it is recognized that the phrase "consisting essentially of" narrows the scope of the claims to the specified materials and those which do not materially affect the basic and novel characteristics of the claimed invention, absent a clear indication of what the basic and novel characteristics are, "consisting essentially of" is construed as equivalent to "comprising". Further, the burden is on the applicant to show that the additional ingredients in the prior art, i.e. additional resin and wax, would in fact be excluded from the claims and that such ingredients would materially change the characteristics of the applicant's invention, See MPEP 2111.03.

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10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Callie E. Shosho whose telephone number is 703-305-0208. The examiner can normally be reached on Monday-Friday (6:30-4:00) Alternate Fridays Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 703-306-2777. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.



Callie E. Shosho
Primary Examiner
Art Unit 1714

CS
8/21/03